

REMARKS/ARGUMENTS

This application has been rejected on the grounds of estoppel, whether there is error under the Reissue statute, and whether the Reissue Declaration is defective.

All three of the rejections turn on the issue of whether a fiber “having only one single-mode core” is patentably distinct from a fiber “having a single-mode core”. Reconsideration of this issue is respectfully requested.

Applicant respectfully asserts that a fiber having only one single-mode core is patentably distinct from a fiber having a single-mode core for the following reason.

1. The Interference Counts are Supported by the Grasso et al. Patent which Teaches Away From Making An Amplifier With A Single Core Gain Fiber

The prior art in this matter is the Grasso et al. patent which states that an amplifier having a single core gain fiber which they produced for comparison with their example fiber introduced such noise that signal reception was difficult so that the amplifier was “practically useless”. (Col. 10, lines 56-61.) This is a textbook case of teaching away from the invention which Hall et al. had made. See **MPEP § 2145 X. D. References teach away from the invention or render prior art unsatisfactory for intended purpose and In re Hedges** 783 F.2d 1038, 1041 (Fed. Cir. 1986).

In **Hedges** the claim at issue related to a process for preparing sulfonic acids. The prior art references taught that lower temperatures of reaction are preferable. **Hedges** claimed a reaction in the molten state. The prior art taught away from the claimed invention of carrying out the reaction in the molten state. This was strong evidence of unobviousness citing *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 USPQ 303,

312 (Fed. Cir. 1983), *cert. denied*, 105 S. Ct. 172 (1984), citing *United States v. Adams*, 383 U.S. 39, 148 USPQ 479 (1996). **Hedges 783 F 2d 1041 (Fed. Cir. 1986.)**

In the present case Grasso et al. states that only a double core fiber will provide the desired attenuation characteristics. Hall et al. claims using a fiber with a single-core. The claimed invention is unobvious.

2. Hall et al. Have Retained The Function Of Selected Attenuation While Eliminating A Core.

The amplifier claimed herein has “only one single-mode core” but it still performs the function of selected attenuation.

The MPEP states at §2144.04:

II. ELIMINATION OF A STEP OR AN ELEMENT AND IT'S FUNCTION

...

B. Omission of an Element with Retention of the Element's Function Is an Indicia of Unobviousness

Note the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F. 2d 896, 149 USPQ 556 (CCPA 1966)(emphasis is in the original).

In *Edge* the claims were directed to a printed sheet having a thin layer of erasable material bonded directly to the sheet whereas the prior art disclosed a similar printed sheet with an intermediate transparent layer between the sheet and the layer of erasable material. *Edge* eliminated the transparent layer but maintained the function of erasing the middle layer without erasing the printed indicia. Similarly, in the present case, Hall, et al. have eliminated a core in the gain fiber, but have retained the function of selectively attenuating certain wavelengths of light. This is an indicia of unobviousness

The examiner has not addressed these arguments in the Official Action. If the claims at issue here are patentably distinct from the counts of the interference, estoppel does not

apply. Estoppel applies only if a losing party who could have properly moved but failed to move under sections 37 C.F. R. §§ 1.633 or 1.634, is estopped to take *ex parte* or *inter partes* action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move.

Claims 35-50 were added to this application in a Preliminary Amendment filed June 26, 1998. The REMARKS of that amendment referred to the original Hall 069 patent which was involved in interference. The REMARKS also referred to the Grasso patent as having a "double core" fiber. The newly submitted claims could not be added to the interference because Grasso et al. did not have support for claims reciting "only a single core". Hall et al. has consistently argued that the single core fiber recited in claims 21-50 was patentably distinct from the "double core" fiber of Grasso et al.

The only actions *in ex parte* prosecution that Rule 658 (c) proscribes are those that are *inconsistent* with a party's failure to file a motion in an interference under Rules 633 or 634:

A losing party who could have properly moved, but failed to move, under § 1.633 or 1.634, shall be estopped to take *ex parte* or *inter parte* action in the Patent and Trademark Office after the interference *which is inconsistent with that party's failure to properly move*(37 CFR § 1.658(c), emphasis added).

Applicants' pursuit of claims 35-50 is entirely *consistent* with the above-noted absence of interference-related activity. Indeed, by not seeking to have these claims added to Interferences 104,069 and 104, 075 or made the subject of another interference against Grasso, *et al.*, Applicants were adopting precisely the same position that they are adopting here – *i.e.*, that the claimed subject matter is patentably distinct from the subject matter of Interferences 104,069 and 104,075 and from the Grasso, *et al.*, patent. Applicants are entitled

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to make a showing in the instant application that the presently claimed invention is not substantially the same as that of the lost count of interferences 104, 069 and 104, 075.

A losing party to an interference is entitled to claim subject matter other than that of the interference count, provided the requirements of patentability are met, and subject to those constraints that flow from the adverse decision in the interference. *In Zletz*, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989).

The estoppel provision of Rule 658(c) is plainly inapplicable. Applicants therefore respectfully request that the rejection of claims 35-50 due to alleged estoppel be reconsidered and withdrawn.

Similarly the rejection based on “no error” falls because the claims presented here are patentably distinct from the interference count. Examiner’s statement that “any amplifier with only one single-mode core would certainly infringe upon the issued claims in Patent No. 5,131,069” is completely irrelevant. Many patents issue with narrower claims than an issued patent, for example, the dominant ‘069 patent. This is common in patent law. The only requirement for issuance of the narrower claims is that they be patentably distinct from the broader patent with the dominant claim. That is the case here.

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The claims in issue here are narrower in scope than the original claims because of the distinction added by reciting "only one single-mode core". This application complies in all respects with 35 U.S.C. §251 including the reissue Declaration which states that it was an error not to present claims reciting "only one single-mode core".

Upon an indication of allowability, the original patent will be surrendered.

Reconsideration and allowance of this application is respectfully requested.

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